

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 09/509,853 Examiner: R. Stormer  
Inventor: Raymond De Cagny Group Art Unit: 3617  
Filing Date: June 8, 2000 Date: April 15, 2002  
Title: Wheel-balancing device and wheel equipped with such a balance device

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Appeal Brief under 37 CFR §1.192

Assistant Commissioner for Patents  
Washington, D.C. 20231

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GROUP 3600

This is an Appeal of the Examiner's final rejection dated September 05, 2001, Paper No. 13, and the subsequently issued Advisory Action dated February 11, 2002, Paper No. 16. This brief is being filed in triplicate with the associated fee under 37 CFR §1.17(c) in the amount of \$320.00. All applicable extension of time fees were previously paid. If any further fee is deemed to be due, the Commissioner is hereby authorized to charge same to the undersigned's Deposit Account No. 22-0212.

Adjustment date: 06/24/2002 EEKUBAY1  
05/02/2002 BTEFFERA 00000003 09509853  
01 FC:120 -320.00 DP

REAL PARTY IN INTEREST

Repln. Ref: 06/24/2002 EEKUBAY1 0000252000  
DAI:220212 Name/Number:09509853 The real party in interest is Fonderie De Gentilly as the assignee in this  
FC: 704 \$160.00 CR

application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect or be affected by or having a bearing on the Board's decision in this Appeal.

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### STATUS OF THE CLAIMS

The status of the Claims as determined by the Examiner in the Final Office Action, Paper 13, and the subsequently issued Advisory Action dated February 11, 2002, Paper No. 16, is as follows:

- a) Independent Claims 1 and 20 and Dependent Claims 2 through 4, 6 through 19, 21 through 24, and 26 through 28 stand finally rejected under 35 USC §102(b) and /or 35 USC §103(a); and
- b) Claims 5 and 25 were not substantively addressed in the Final Office Action or the Advisory Action.

### STATUS OF AMENDMENTS

A reply to the Examiner's final rejection under 37 CFR §1.116 was filed on December 20, 2001 requesting the Examiner's reconsideration of the final claim rejections under 35 U.S.C. §§102 and 103. In an Advisory Action dated February 11, 2002, Paper No. 16, the Examiner continued the 35 U.S.C. §§102 and 103 as to Claims 1 through 28 but, did indicate that the reply would be entered upon filing of a Notice of Appeal and that the reply would overcome all of the rejections under 35 USC 112, 2<sup>nd</sup> paragraph, as well as the objections to the drawings, specification, and claim 20.

### SUMMARY OF THE INVENTION

Generally, Appellants' invention discloses a balancing weight enclosed within a case that is fixed to the sidewall of the tire. The case is composed of a material that matches the color of the tire so as to blend together therewith. The balancing weight

is preferably composed of lead, but can be composed of almost any material, and a standard balancing weight can also be used. The ideal location and weight required to balance a wheel assembly are established by conventional balancing procedures.

Appellants teach constructing the weight enclosed in a case such that the total weight of the combination is equivalent to the ideal weight established through conventional balancing procedures. The wheel assembly is balanced using a single device by attaching the appropriate weight enclosed in a case at the ideal location established through conventional balancing procedures. As Appellants disclose mounting a balancing device to the sidewall of a tire, there is no potential for damage to the rim by the device and the geometry of the rim is irrelevant for purposes of attachment.

The invention also proposes a wheel with a rim having a tire and balancing device having a balancing weight enclosed in a case, the surface of which is integral with a surface of the tire and which is made of a material having a similar colour to that of the tire.

### ISSUES

The issues to be resolved in this appeal are as follows:

1. Are Claims 1, 2, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, and 23 as rejected under 35 U.S.C. §102(b) unpatentable as being anticipated by Woolson (U.S. Patent 1,692,145).
2. Are Claims 20 and 27 as rejected under 35 U.S.C. §102(b) unpatentable as being anticipated by Thissen et al (EPO 222391).
3. Are Claims 3, 4, 6, 18, 19, 21, and 24 as rejected under 35 U.S.C. §103(a) unpatentable as obvious over the teachings of Woolson (U.S. Patent 1,692,145).

4. Are Claims 13, 15, 16, and 28 as rejected under 35 U.S.C. §103(a) unpatentable over Woolson in view of Turoczi Jr. (U.S. Patent 3,786,850).

5. Is Claim 26 as rejected under 35 U.S.C. §103(a) unpatentable over Woolson in view of Flebbe (German 3632981).

#### GROUPING OF THE CLAIMS

For each ground of rejection that applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

#### ARGUMENT

##### The Rejection of Claims 1, 2, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, 23, and 27 under 35 U.S.C. §102(b) is Improper as a Matter of Law and Issue 1 and Issue 2 Should be Resolved in Appellant's Favor

The Examiner rejected Claims 1, 2, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, and 23 under 35 U.S.C. §102(b) as being anticipated by Woolson, U.S. Patent 1,692,145, and further rejected Claims 20 and 27 as being anticipated by Thissen et al., EPO 222391. The undersigned attorney respectfully traverses the Examiner's rejections of independent Claims 1 and 20, and dependent Claims 2, 7, 8, 9, 10, 11, 12, 14, 17, 22, 23 and 27 in view of the following argument for the reason that the claims are not anticipated by either Woolson or Thissen et al.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals of the

Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ. 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. §102, the Court stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Appellants’ independent Claim 1 requires:

“1. A balancing device for a tire mounted to a wheel, said balancing device comprising:  
a **case** having at least one surface thereon; and  
a **single balancing weight enclosed in said case**,  
said at least one surface of said case having means for mounting said case to said tire.”

Applicants’ independent Claim 20 as amended requires:

“20. A wheel assembly including a rim having an axis, a tire and a balancing device, said balancing device comprising:  
a **case** having at least one surface thereon; and  
a **single balancing weight enclosed in said case**,  
said at least one surface of said case being firmly mounted to a surface of a side of said tire.”

Woolson does not disclose a single balancing weight. Rather, Woolson discloses a tire casing having a plurality of integral patch-like members, apertures in said members and weights secured in said apertures. The Examiner’s contention that “The articulated links 10 comprise a single weight in the assembled device of the links and the case” (item number 13 of the Office Action mailed on 9/05/01) misses the point that Woolson requires a plurality of the assembled devices. Woolson discloses a plurality of the assembled devices (each including a weight) secured at regular intervals to a tire casing such that the wheel assembly remains balanced regardless of the orientation of the tire casing relative to the rim. The tire assembly disclosed in Woolson cannot remain balanced with one single weight. Woolson requires multiple sites each having an adjustable weight

system to ensure that a tire casing will remain balanced. Therefore, Woolson does not meet the limitation of a single weight.

Furthermore, Woolson does not disclose anything of any kind being enclosed in a case. Firstly, there is no case disclosed in Woolson. Woolson discloses an integral “patch-like member” with “perforations” having the articulated links threaded and distributed therethrough. One of ordinary skill in the art would not confuse an integral patch with a case, nor does the Woolson specification support such a broad interpretation of the term patch. Secondly, the articulated links are not enclosed within the patch-like member. The term “enclosed” is defined as closed in or surrounded. The patch-like member of Woolson cannot possibly close in or surround the weights, because the weight can “have portions added thereto or taken therefrom” as exemplified in Figure 3 wherein articulated links can extend outside of the patch-like member. Therefore, the patch-like member of Woolson must be open such that the articulated links can be exposed, thereby also exposing the inside of the patch-like member.

Finally, Woolson does not disclose means for mounting a case to a tire, nor is a case mounted to a tire. Rather, Woolson provides a tire with a plurality of patch-like members integrally manufactured onto the side of the tire by a process of vulcanization such that the patch-like members have no separate surface of their own that affix to the tire. Woolson does not disclose a means for mounting the integral patch-like members because the members are integrally manufactured onto the tire casing before the tire is assembled to the wheel. The process described in Woolson is possible because the location of the integral patch members is not critical and does not vary from tire to tire. Appellants’ disclosure includes a case with a means for mounting so that the case can be attached at a specific, predetermined location on the tire. The appropriate location for the case cannot be

determined until the tire is attached to the wheel, and the appropriate location will vary from tire to tire. By using a single case with a means for mounting, Appellants structurally differ from Woolson's plurality of patch-like members.

Thissen et al. fail to disclose a case member separately mounted to a side of a tire. The balancing skims in Thissen et al. are fitted in between a tire and a rim flange. They are not mounted to the tire. Appellants' disclosure provides a means for balancing a wheel assembly regardless of wheel and/or rim geometry, while Thissen et al. require a specific rim with a specific flange because the balancing skim is not mounted to the tire.

Based upon the above argument, Appellants respectfully submit that neither the Woolson nor the Thissen et al. references disclose each and every element arranged as in the claim of any of Appellants' independent claims. Therefore, in applying the test for anticipation as set forth in *Lindemann*, neither Woolson nor Thissen et al. anticipate either of Appellants' independent claims.

The rejection of dependent Claim 2 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 2 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the balancing weight be made of lead material.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 2 that the weight be made of a lead material is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 7 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of

the structure of the independent claim for which they depend. Claim 7 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that at least one surface include a concave portion.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 7, that at least one surface include a concave portion is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 9 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 9 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the balancing weight has an approximate rectangular cross section.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 9, that the balancing weight has an approximate rectangular cross section is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 10 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 10 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the case has an approximately constant thickness.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the



additional limitation of Claim 10, that the case has an approximately constant thickness is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 11 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 11 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the case is made of a flexible material.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 11, that the case is made of a flexible material is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 12 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 12 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the case further comprises sections and passages, the sections passing through the passages of the balancing weight.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 12, that the case further comprises sections and passages, the sections passing through the passages of the balancing weight is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 14 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of

the structure of the independent claim for which they depend. Claim 14 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the at least one surface is delimited by borders that define edges.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 14, that the at least one surface is delimited by borders that define edges clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 17 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 17 requires the combination of elements of the structure as set forth in Claim 1 with the additional limitation that the case is black.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 1, and accordingly, the additional limitation of Claim 17, that the case is black is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 22 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 22 requires the combination of elements of the structure as set forth in Claim 20 with the additional limitation that the balancing device is mounted along a side of the tire close to the rim.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 20, and accordingly, the additional limitation of Claim 22, that the balancing device is mounted along a side of the tire

close to the rim is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 23 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 23 requires the combination of elements of the structure as set forth in Claim 20 with the additional limitation that wherein said tire further comprises a section of maximum width and the balancing device is mounted radially between the rim and the section of maximum width.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 20, and accordingly, the additional limitation of Claim 23, that the balancing device is mounted along a side of the tire close to the rim is clearly patentably distinct and not anticipated by the disclosure of Woolson.

The rejection of dependent Claim 27 under 35 U.S.C. §102(b) is not well taken especially in view of the fact that the dependent claims are but further delineations of the structure of the independent claim for which they depend. Claim 27 requires the combination of elements of the structure as set forth in Claim 20 with the additional limitation that the rim further has an edge thereon and a circumferential groove defined between the edge of the rim and tire, the balancing device being engaged in said circumferential groove.

As clearly shown in the above argument, the Woolson reference fails to disclose each and every element arranged as in independent Claim 20, and accordingly, the additional limitation of Claim 27, the rim further has an edge thereon and a circumferential groove defined between the edge of the rim and tire, the balancing device being engaged in

said circumferential groove is clearly patentably distinct and not anticipated by the disclosure of Thissen et al.

Based upon the above arguments, Appellants respectfully submit that neither the Woolson nor the Thissen et al. references disclose each and every element arranged as in the claim of any of Applicants' independent or dependent claims. Therefore, in applying the test for anticipation as set forth in *Lindemann*, neither Woolson nor Thissen et al. anticipate either of Applicants' independent and dependent claims. Further, under principles of claim dependency, Woolson and Thissen et al. do not anticipate any of the dependent claims either. Accordingly, reconsideration and withdrawal of the rejection of independent Claims 1 and 20 as well as dependent Claims 2, 7, 8, 9, 10, 11, 12, 14, 17, 22, 23 and 27 under 35 U.S.C. §102(b) are respectfully requested.

The Rejection of Claims 3, 4, 6, 13, 15, 16, 18, 19, 21, 24 and 26 through 28, under 35 U.S.C. §103(a) is Improper as a Matter of Law and Issue 3, 4, and 5 Should be Resolved in Appellant's Favor

The Examiner rejected dependent Claims 3, 4, 6, 18, 19, 21 and 24 under 35 U.S.C. §103 as being unpatentable over the teachings of Woolson. The Examiner also rejected dependent Claims 13, 15, 16 and 28 under 35 U.S.C. §103 as being unpatentable over the teachings of Woolson in view of the teachings of Turoczi, Jr., U.S. Patent 3,786,850, and further rejected dependent Claim 26 as being unpatentable over the teachings of Woolson in view of the teachings of Flebbe, DE 3632981.

Appellants' attorney respectfully traverses each of the 35 U.S.C. §103 rejections set forth herein for the reason that Appellants' invention is not an obvious improvement over the prior art.

With respect to the rejections under 35 U.S.C. §103, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 USPQ 459 (1966), where the Court stated:

“Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.”

Accordingly, to establish a prima facie case of obviousness, the Patent Office must; (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference or implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). Prior to discussing the unobviousness of the present invention over the prior art, the teachings of the prior art references and the differences, novelty, and unobviousness of the present invention over the prior art references will be set forth.

Woolson is directed to the problem of wheel assembly imbalance due to inequalities of balance in the tire casing itself resulting in the need to rebalance the tire upon removal and re-assembly of a tire casing to a wheel. To overcome this problem Woolson teaches a way to inherently balance a tire casing so that the wheel assembly may not be thrown out of balance regardless of the orientation of the tire casing relative to the wheel itself.

To solve this problem, Woolson teaches a plurality of patch-like members integrally manufactured to the side of a tire casing before the tire is assembled to the wheel.

The integral patch-like members are evenly spaced around the perimeter of the tire casing. Each patch-like member is provided with perforations through which a plurality of articulated links of weight material are threaded. After the tire is assembled to the rim, the articulated links of weight material are either added to or subtracted from the integral patch-like members to achieve balance. It is important to point out that Woolson specifies a plurality of patch-like members because it is not possible to balance a wheel assembly by arbitrarily adding weight to a single location on a tire casing. Woolson relies on a plurality of circumferentially spaced patch-like members so that weight can be added to or subtracted from any area of the tire as determined after the tire is assembled to the wheel.

Turoczi, Jr., is directed to the problems associated with maintaining wheel assembly balance by clamping lead weights to a rim. Specifically, Turoczi, Jr. mentions their unseemly appearance and deleterious effects on magnesium-chrome wheels. Accordingly, Turoczi, Jr. teaches using indicia-shaped balance weights to more attractively balance a tire and identify a tire and wheel assembly so as to deter theft.

Turoczi, Jr. accomplishes this objective by providing a balanced wheel having a plurality of balance weights affixed to the sidewalls of a tire. Each balance weight is composed of a solid mass of rubber, is shaped as a letter or a logo, and is affixed to the tire with rubber cement. Reference the Background section of Appellants' application for various problems and disadvantages of the Turoczi, Jr. balance weights. Note that there is absolutely no teaching or suggestion in Turoczi, Jr. of using a balance weight enclosed in a case. Instead, Turoczi, Jr., specifically teaches use of a solid mass of rubber affixed to the sidewall of the tire.

Flebbe is directed to the problem of fitting and moving wheel assembly balancing weights. To overcome this problem Flebbe teaches a way to secure a weight to a

wheel assembly by wedging a fastener between the tire and an edge of the wheel rim. To accomplish the teachings, Flebbe discloses a cover ring between the tire and wheel rim. A holder is fitted on the cover ring to hold a balancing weight. As in Thissen et al., Flebbe requires specific rim geometry to generate the forces necessary to hold the balancing weight in place.

In contrast, Appellants' invention is directed to the prior art problems of damage to a wheel rim associated with attachment of a balancing weight and implementation of a single balancing weight on tires without relying on peripheral rim flanges. Appellants teach balancing a wheel and tire assembly by attaching a balancing device to the sidewall of the tire.

Appellants' invention discloses a balancing weight enclosed within a case that is fixed to the sidewall of the tire. The case is composed of a material that matches the color of the tire so as to blend together therewith. The balancing weight is preferably composed of lead, but can be composed of almost any material, and a standard balancing weight can also be used. The ideal location and weight required to balance a wheel assembly are established by conventional balancing procedures. Appellants teach constructing the weight enclosed in a case such that the total weight of the combination is equivalent to the ideal weight established through conventional balancing procedures. The wheel assembly is balanced using a single device by attaching the appropriate weight enclosed in a case at the ideal location established through conventional balancing procedures. As Appellants disclose mounting a balancing device to the sidewall of a tire, there is no potential for damage to the rim by the device and the geometry of the rim is irrelevant for purposes of attachment. According to the discussion above with respect to the prior art references, these are patentably significant differences as set forth below

between Appellants' invention and any combination of the teachings Woolson, Turoczi, Jr., Thissen and Flebbe.

The differences between Appellants' invention and the Woolson reference cited by the Examiner in the rejection under 35 U.S.C. §103 are quite clear. The solution taught by Woolson is directed to problems totally different than that described in Appellants' invention. Woolson addresses the problem of maintaining wheel assembly balance regardless of the tire's orientation relative to the rim. In contrast, Appellants' disclosure is directed to the problems of damage to a wheel rim associated with attachment of a balancing weight and implementation of a single balancing weight on the tires without relying on peripheral rim flanges. The Woolson reference does not address the problem of damage to a rim associated with attachment of a balancing weight. Appellants' invention points out a problem and teaches a solution to a problem that was not present, much less recognized, by Woolson.

Furthermore, it is technically impossible for the Woolson disclosure to maintain wheel assembly balance with a single weight. Woolson relies on a plurality of integral patch-like members, each having articulated weights, distributed around the perimeter of a tire casing. The appropriate location for balancing a wheel assembly with a single weight cannot be determined until the entire wheel assembly is balanced with conventional methods. As Woolson attaches the integral patch-like members to the tire casing before the tire is mounted onto the rim, application of a single patch-like member would result in an unbalanced wheel assembly. Appellants' disclosure functionally and structurally replaces the plurality of integral patch-like members with a single case.

Even if, as the Examiner suggests, the teachings of Woolson and Turoczi, Jr. or Woolson and Flebbe are combined, one skilled in the art would have no basis for making



such a combination. It is respectfully suggested that, but for the disclosure made by the Appellants in the application, there is no suggestion whatsoever to combine the teachings of Woolson and Turoczi, Jr. or Woolson and Flebbe in order to obviate Appellants' invention as taught by the Appellants and recited in the claims presently pending in the application. Moreover, any such combination simply would not result in Appellants' invention

If, as the Examiner suggests, Woolson is combined with Turoczi, Jr. in an attempt to obviate Appellants' invention, the suggested combination would not result in Appellants' invention and would in fact require extensive additional structure in an attempt to acquire similar results. Specifically, neither reference teaches a structure encasing a balancing weight, and neither reference teaches a single structure capable of balancing a wheel assembly. The Examiner rejected dependent Claims 13, 15, 16 and 28 as being unpatentable because Turoczi, Jr. suggests the use of glue as a means to attach the patch-like members of Woolson. However, a combination of references resulting in a plurality of patch-like members glued to the sidewall of a tire still does not suggest a case to hold a balancing weight or a single device to balance a wheel assembly. Woolson discloses a plurality of integral patch-like members through which weights are threaded. The threaded weights are exposed at both ends of the patch-like members and the weights are not encased or enclosed. Turoczi, Jr. teaches affixing a plurality of solid blocks of rubber shaped like letters or logos to a tire. As neither reference suggests a case to hold a balancing weight or a single device to balance a wheel assembly, the combination cannot possibly make such a suggestion to a person skilled in the art.

Finally, the Examiner contends that the tire with a circumferential groove for the reception of a balancing device as described in Claim 26 is unpatentable over Woolson

in view of Flebbe. The groove referred to in Claim 26 is in the tire, whereas the groove described in Flebbe is in the rim between the tire and a rim flange. One of the primary advantages of Appellants' disclosure is a means for implementing a balancing system on a wheel assembly without reliance on a rim flange. The Examiner's combination of the teachings of Woolson and Flebbe would at best result in a plurality of patch-like members mounted in a groove between the tire and a rim flange. Frankly, the Examiner's combination of prior art references would be incompatible with itself and inoperative in view of the objective set forth in Woolson. Woolson teaches threading linked weights into a plurality of patch-like members as required to maintain wheel assembly balance. The process of threading linked weights into a plurality of patch-like members would become far more cumbersome if the members were embedded into a groove between the tire and a peripheral rim flange.

Therefore, it is respectfully submitted that, but for the disclosure made by the Appellants in the application, there is no teaching, suggestion, or motivation whatsoever to take the teachings of Woolson alone or in combination with the teachings of Turoczi, Jr. or Flebbe to in any way obviate Appellants' invention as taught by the claims presently pending in the application. None of the references teach or suggests a single balance weight enclosed in a case that is mounted to a tire.

It is well settled patent law that the mere fact that a disclosure can somehow be combined with other references does not make that combination obvious unless the prior art contains some suggestion of the desirability for combining the prior art references. In other words, to satisfy step (3) of the prima facie case of obviousness above, there must be "some teaching, suggestion, or motivation to combine the references," as recently summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456

(Fed. Cir. 1998). Here, the prior art contains absolutely no suggestion whatsoever for combining the references to teach the invention as claimed according to Appellants' disclosure.

Accordingly, Appellants respectfully assert that the Examiner would have to use improper hindsight reconstruction in an attempt to obviate Appellants' invention after having the benefit of reading Appellants' application. Absent recognition of the problem faced by the Appellants, the prior art cannot possibly suggest, singularly or in combination, a solution as novel as Appellants' invention. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

In view of the foregoing remarks, the undersigned attorney respectfully submits that the pending independent and dependent claims are in proper form, defined patentably over the prior art and are clearly allowable. Appellants' attorney therefore respectfully request that this Honorable Board overturn the Examiners rejection of independent claims 1 and 20 and dependent claims 3, 4, 6, 13, 15, 16, 18, 19, 21, 24 and 26 through 28 under 35 USC 103(a) and that a formal notice of allowance be issued therefor.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the rejections of Claims 1 through 28 are improper as a matter of fact and law under both 35 USC §102(b) and 35 USC §103(a), and reversal of the final rejections of the claims as appealed is therefore respectfully requested.

An Appendix that contains the claims on appeal, as pending at the time of the final rejection, is enclosed herewith.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



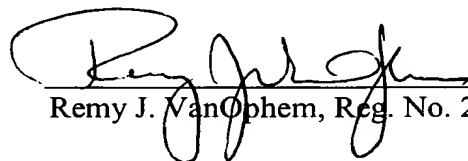
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